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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,603	12/28/2000	Katherine E. Hayes	XER 2 0346	6753

7590 04/24/2006

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EXAMINER

KARMIS, STEFANOS

ART UNIT PAPER NUMBER

3624

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/750,603	<b>Applicant(s)</b> HAYES ET AL.	
	<b>Examiner</b> Stefano Karmis	<b>Art Unit</b> 3624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The following communication is in response to Applicant's amendment filed 09 December 2004.

#### ***Status of Claims***

2. Claims 1-16 and 19-23 are currently amended. Claims 17 and 18 are original. Therefore claims 1-23 are currently pending.

#### ***Response to Arguments***

3. Applicant's arguments, filed 09 December 2004, with respect to the rejection(s) of claim(s) 1-23 under 35 U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as discussed below.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18, 20 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5. The term "arbitrarily" in claims 1, 6, 16, 20 and 23 is a relative term which renders the claim indefinite. The term "arbitrarily" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For examining purposes, the Examiner interprets "arbitrarily" to mean "at least one." Claims 2-5, 7-15, 17 and 18 are rejected under 35 U.S.C. 112, second paragraph because of their dependency on claims, which contain the "arbitrarily" term.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-7, 16, 17 and 19-23 rejected under 35 U.S.C. 102(e) as being anticipated by Maruta et al. (hereinafter Maruta) U.S. Patent 6,516,157.

Regarding independent claims 1, 6, 20 and 21, Maruta discloses a configurable billing system for a machine, the machine operative to output a product or a service and including a plurality of aspect sensors, the sensors operative to detect the delivery of aspects of the product or service and to report the delivery to the billing system, the billing system comprising: a coded billing strategy including an arbitrarily long list of

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aspects of interest and an arbitrarily long list of meter descriptions defines for the machine (column 10, lines 1-10); and a plurality of meters updated by the billing system for recording the delivery of the aspects of the product or service based on the billing strategy, whereby the billing system tallies the aspects in a manner defined in the billing strategy (column 9, lines 20-53 and column 10, lines 1-10).

Claim 2, the coded billing strategy further comprises information regarding a format in which information regarding the aspect of interest will be communicated to the billing system by the machine (column 11, lines 51-57).

Claim 3, wherein each meter in the list of meters is described as a function of at least one of the listed aspects of interest (column 10, lines 23-34).

Claim 4, wherein the coded billing strategy comprises information associated with the listed meters, the information describing the function of the meters (column 10, lines 43-53).

Claims 5 and 7, wherein the plurality of meters are instantiated in memory, by the billing system, according to the coded billing strategy (column 10, lines 14-21).

Regarding independent claims 16, 19 and 22, Maruta discloses a document processing system comprising: a print engine (column 2, lines 53-57); a configurable billing system operable to follow a billing strategy specification including an arbitrarily

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long list of document production events of interest, an arbitrarily long list of meter descriptions and a machine readable script for updating the meters defined in the list to record the occurrence of document production events as described in the billing strategy defines for the machine (column 9, lines 20-53 and column 10, lines 1-10); and a marker module operative to control the print engine in the production of documents, and to report document production events to the billing system (column 10, lines 43-63).

Claim 17, wherein the marker module is operative to deliver the billing strategy to the billing system (column 10, lines 43-63).

Regarding independent claim 23, Maruta discloses a document processor operative to produce printed documents, the document processor comprising: a print engine (column 2, lines 53-57); at least one aspect sensor operative to sense and report at least one of an impression count, an impression event, a set count, a diagnostic impression event, a media description, a use of highlight color and a use of full color related to a production of a document (column 9, lines 20-24); a billing strategy file defining a billing strategy in machine readable form, the billing strategy file describing an arbitrarily large number of mathematical functions of an arbitrarily large number of meters for processing and recording information reported by the at least one aspect sensor (column 10, lines 1-10); a billing module operative to receive the billing strategy file and instantiate the arbitrarily large number of meters according to the billing strategy (column 10, lines 43-63) and a marker module operative to control the print engine in the production of a document (column 10, lines 43-63).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 8-15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruta et al. (hereinafter Maruta) U.S. Patent 6,516,157.

Claims 8-15, Maruta teaches that the list of aspects of interest comprises document size, ACS determination result, and the number of documents for each type (column 9, lines 20-24). Maruta fails to specify other aspects of interest such as impression count, impression event flag, set count, set completion flag, diagnostic impression flag, media descriptor, highlight color flag or a full color flag. Official Notice is taken that many aspects of interest can be used for billing. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Maruta and include these as aspects of interest in the billing system because they are specialized characteristics upon which cost can be calculated just as with size, color and quantity.

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Claim 18, Maruta teaches a print engine. Maruta fails to teach a xerographic printer. Official Notice is taken that a xerographic printer is old and well known in the arts. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Maruta and include xerographic printers because they are commonly used and provide output similar to other print engines on which the billing system is based.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (571) 272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted  
Stefano Karmis  
03 October 2005



VINCENT MILLIN  
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